

### REMARKS

The present invention seeks to provide a novel effect in a relatively inexpensive fashion that can be used, for example in mobile telephones and digital cameras with an image display function. From the globalization of the electronic industry, a highly competitive environment exists where consumers are expecting more features at a reduced cost.

The present invention addresses these issues by eliminating a component cost of a frame memory and recognizing the desirability to provide relative compact miniaturized handheld electronic devices that can employ the advantages of the present invention.

“Thus when differences that may appear technologically minor nonetheless have a practical impact, particularly in a crowded field, the decision-maker must consider the obviousness of the new structure in this light.”

*Continental Can Co. USA Inc. v. Monsanto Co.*, 20 U.S.P.Q. 2d. 1746, 1752 (Fed. Cir. 1991).

The present invention has recognized the advantages of utilizing a pair of LCD modules which include a graphic random access memory (GRAM) while configuring the control system with operational instructions to employ the GRAM component in a manner that permits an elimination of a conventional component of a frame memory, thereby realizing both the savings in cost and size while maintaining novel features for the user.

The cited prior art, at least with regards to the technical features relied upon in formulating the present rejection, neither recognize nor teach the utilization of a pair of LCD modules in the manner utilized and claimed by the present applicant.

The Office Action rejected Claim 9 under 35 U.S.C. §101. It is believed that Claim 9 has now been appropriately amended to moot this rejection. Applicant wishes to express gratitude for the commentary on the computer readable medium by the Examiner.

Claims 2, 3, 5 and 9 were rejected as anticipated by *Lanier* (U.S. Patent No. 6,400, 374) under 35 U.S.C. §102.

The Office Action further contended that certain features were inherent in supplementing the rationale of this rejection.

“[A]nticipation by inherent disclosure is appropriate only when the reference discloses prior art that must *necessarily* include the unstated limitation. . . .”

*Transclean Corp. v. Bridgewood Services, Inc.*, 290 F.3d 1364, 62 USPQ2d 1865 (Fed. Cir. 2002)

The *Lanier* reference refers to a computer based graphic image system that permits the face of a person to be superimposed as a foreground image in an Avatar computer generated image. Purportedly, this can have a particular application in a video game so that the individual can personalize an Avatar character with his or her face. A video camera connected to a control system, such as a computer 12 shown in Figure 1, is capable of receiving position signals, for example from an electromagnetic field generator 6 that are received by a sensor 8 mounted on headphones 10 on the user.

Based on the detected location signals, a background video generator can generate an animated character or Avatar, while positioning a chromatic or blue facial area to define a border of the user's face on a computer image of a body. As can be seen on the video display 4, the border area 18 delineates the live image of the user's face within the environment of the animated graphic image. Presumably this graphic image then interacts with its environment in a virtual reality with other players or computer generated character, for example in a computer game.

Alternative embodiments are disclosed and generally relate to identifying the location and position of the human face to permit the computer system to appropriately superimpose the

face within the Avatar background, from a video generator or animation generator, shown for example in Figure 2. The embodiment of Figure 2 utilizes acoustical transmitters for determining positioning. Other position tracking systems are contemplated and as shown in Figure 5, remote players can participate in a common superimposed set of images.

The Office Action contended that the personal computers 93 and 105 shown in Figure 5 purportedly have inherent display graphic memories.

“Inherency ‘may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.’”

*Continental Can Co. USA Inc. v. Monsanto Co.*, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991).

Hypothetically accepting this premise, it would appear to be equally valid that the same system and apparatus, including the personal computers, would employ buffer or frame memories along with other electronic components which would raise both the cost and size of the system.

The *Lanier* reference, however, is not concerned in miniaturization nor any removal of unnecessary buffer memories. *Lanier* does not suggest that an LCD module, having a graphic memory, could be employed in a manner as defined, for example in the second transfer unit of our Claim 2.

Needless to say, the *Lanier* reference does not teach or suggest our claim elements and the manner of operation of such a transfer unit, and could not qualify as an anticipatory reference, nor in fact as a 35 U.S.C. §103 reference.

Our invention as set forth, for example in Claim 2 and our other independent claims, specify a specific LCD module with a graphic memory for displaying a pre-composite image on the LCD screen. This graphic memory can also serve in place of the conventional function of a

buffer memory for image composition. The pre-composite image data combined in the graphic memory with an image taking operation, and the read image data and frame image data are then composed. The composite image data can be transferred to the graphic memory of the second LCD module graphic memory and displayed on a second LCD display.

As can be appreciated, the cost of a buffer memory is thereby eliminated since our respective LCD modules can be used exclusive from any buffer or frame memory.

The Supreme Court case of *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966) required first determining the scope and content of the prior art and then ascertaining the differences between the claimed invention and the prior art. Here the scope and content of the prior art is a video superpositioning system utilizing personal computers and animation generators along with position detectors. In such an environment, there cannot be found any teachings or suggestion of maximizing the utilization of a pair of LCD modules.

As such, there is differences between our claimed invention and the cited prior art and it has been long recognized that the removal of components to produce a more compact and efficient configuration is suggestive of invention.

The Office Action further cited the *Ohmura et al.* reference basically for its disclosure of a pair of LCD screens or displays in a cellular telephone. One LCD screen being a relatively inexpensive black and white unit that is dedicated for displaying characters and communication information. The second LCD screen being a more expensive multi-color display capable of disclosing an image such as a photograph.

*Ohmura et al.* specifically teaches that the respective first and second LCDs are separately controlled and utilized in a manner to save power.

[0065] The first LCD 331 and the second LCD 332 are separately controlled. When the image is not needed (for example, when the user is

not using the phone and when the user is talking on the phone), only the first LCD 331 operates and the second LCD 332 is turned off to save electricity. When the characters and the image are both needed, they are easy to see since they are not displayed on one LCD. Also, the first LCD 331 is less expensive than the second LCD 332.

As can be appreciated, from a full reading of the disclosure in the *Ohmura et al.* reference, the utilization of an inexpensive LCD and a color LCD is the prime teaching along with the capability of being integrated into a printer. The specifics and the manner of using these pair of LCDs are not elaborated upon, nor is there any teaching or suggestion that these features in the *Ohmura et al.* reference could somehow be incorporated and utilized in the *Lanier* video superposition system, at least in the manner set forth in our current claims.

As cited in the MPEP §2141.02 I. at Pages 2100-123, 124:

In determining the differences between the prior art and the claims, the question under 35 U.S.C. §103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); *Schenck v. Nortron Corp.*, 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983).

In summary, it is respectfully submitted that features in our claims have not been provided appropriate weight from a patentable viewpoint and this is inclusive of the judging step of transferring image data to a graphic memory in the first LCD module and when completed, a second transfer step of compositing the image data with the frame image data so as to generate the composite image data that has been provided exclusively in the graphic memory in the first LCD module and then transferred as a composite image to be displayed on the second LCD module.

The *Ohmura et al.* reference is only concerned with LCDs dedicated to either an image in a color format or character and text dedicated to a less expensive black and white LCD.

It is the Examiner's burden to establish *prima facie* obviousness. See *In re Rijckaert*, 9 F.3d 1531, 1532 (Fed. Cir. 1993) Obviousness requires a suggestion of all the elements in a claim (*CFMT, Inc. v. Yieldup Int'l Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003)) and "a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does." *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007). Here, we find that the Examiner has not identified all the elements of claim 1, nor provided a reason that would have prompted the skilled worker to have arranged them in the manner necessary to reach the claimed invention.

*Ex parte* Karoleen B. Alexander, No. 2007-2698, slip op. at 6 (B.P.A.I. Nov. 30, 2007)

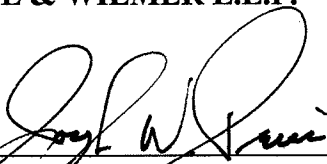
Applicant accordingly submits that there has been a failure to articulate a reason that would have prompted any skilled worker to have attempted to rearrange the LCDs in the *Ohmura et al.* reference in some manner that could replicate the claims in our invention in the video superposition system of the *Lanier* disclosure.

It is believed the case is now in condition for allowance and early notification of the same is requested.

If the Examiner believes a telephone interview will help further the prosecution of the case, the undersigned attorney can be contacted at the listed phone number.

Very truly yours,

**SNELL & WILMER L.L.P.**



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